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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/479,374    06/07/95    HARVEY

J    5634.148

EXAMINER

LM61/0512

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HOWREY & SIMON  
1299 PENNSYLVANIA AVENUE NW  
WASHINGTON DC 20004

WEAVER, S

ART UNIT

PAPER NUMBER

2742  
DATE MAILED:

17  
05/12/98

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

**Advisory Action**Application No.  
**08/479,374**Applicant(s)  
**Harvey et al.**Examiner  
**Scott L. Weaver**Group Art Unit  
**2742**

## THE PERIOD FOR RESPONSE: [check only a) or b)]

- a) ☒ expires three months from the mailing date of the final rejection.
- b) ☐ expires either three months from the mailing date of the final rejection, or on the mailing date of this Advisory Action, whichever is later. In no event, however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

- ☐ Appellant's Brief is due two months from the date of the Notice of Appeal filed on \_\_\_\_\_ (or within any period for response set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).

Applicant's response to the final rejection, filed on Mar 13, 1998 has been considered with the following effect, but is NOT deemed to place the application in condition for allowance:

☒ The proposed amendment(s):

- ☒ will be entered upon filing of a Notice of Appeal and an Appeal Brief.
- ☐ will not be entered because:
- ☐ they raise new issues that would require further consideration and/or search. (See note below).
  - ☐ they raise the issue of new matter. (See note below).
  - ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
  - ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

- ☐ Applicant's response has overcome the following rejection(s): \_\_\_\_\_

- ☐ Newly proposed or amended claims \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claims.
- ☐ The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_

- ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

- ☒ For purposes of Appeal, the status of the claims is as follows (see attached written explanation, if any):

Claims allowed: \_\_\_\_\_

Claims objected to: \_\_\_\_\_

Claims rejected: 2-7

- ☐ The proposed drawing correction filed on \_\_\_\_\_ ☐ has ☐ has not been approved by the Examiner.

- ☐ Note the attached Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

- ☒ Other *The arguments regarding the administrative requirement have been noted, but the administrative requirement as set forth in the previous office Action still stands. As to the 35 USC 102 (a) and (e) and 103(a), these codes were NOT "applied" to the claim, the office action merely presents such codes in a standard format.*

*SLW*  
**SCOTT L. WEAVER**  
PATENT EXAMINER  
Group 2700

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***DETAILED ACTION***

1. This Office Action is responsive to the amendment(s) filed 6/19/97.

***DOUBLE PATENTING V.S. PATENTS***

2. In view of further analysis and applicant's arguments, the rejection of the claims in the instant application under double patenting based on the broad analysis of *In re Schneller* as set forth in paragraphs 7-10 of the previous Office Action has been withdrawn.

3. The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985) *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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***DOUBLE PATENTING BETWEEN APPLICATIONS***

4. Conflicts exist between claims of the following related co-pending applications which includes the present application:

#	Ser. No.	#	Ser. No.	#	Ser. No.
1	397371	2	397582	3	397636
4	435757	5	435758	6	437044
7	437045	8	437629	9	437635
10	437791	11	437819	12	437864
13	437887	14	437937	15	438011
16	438206	17	438216	18	438659
19	439668	20	439670	21	440657
22	440837	23	441027	24	441033
25	441575	26	441577	27	441701
28	441749	29	441821	30	441880
31	441942	32	441996	33	442165
34	442327	35	442335	36	442369
37	442383	38	442505	39	442507
40	444643	41	444756	42	444757
43	444758	44	444781	45	444786
46	444787	47	444788	48	444887

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49	445045	50	445054	51	445290
52	445294	53	445296	54	445328
55	446123	56	446124	57	446429
58	446430	59	446431	60	446432
61	446494	62	446553	63	446579
64	447380	65	447414	66	447415
67	447416	68	447446	69	447447
70	447448	71	447449	72	447496
73	447502	74	447529	75	447611
76	447621	77	447679	78	447711
79	447712	80	447724	81	447726
82	447826	83	447908	84	447938
85	447974	86	447977	87	448099
88	448116	89	448141	90	448143
91	448175	92	448251	93	448309
94	448326	95	448643	96	448644
97	448662	98	448667	99	448794
100	448810	101	448833	102	448915
103	448916	104	448917	105	448976
106	448977	107	448978	108	448979
109	449097	110	449110	111	449248

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112	449263	113	449281	114	449291
115	449302	116	449351	117	449369
118	449411	119	449413	120	449523
121	449530	122	449531	123	449532
124	449652	125	449697	126	449702
127	449717	128	449718	129	449798
130	449800	131	449829	132	449867
133	449901	134	450680	135	451203
136	451377	137	451496	138	451746
139	452395	140	458566	141	458699
142	458760	143	459216	144	459217
145	459218	146	459506	147	459507
148	459521	149	459522	150	459788
151	460043	152	460081	153	460085
154	460120	155	460187	156	460240
157	460256	158	460274	159	460387
160	460394	161	460401	162	460556
163	460557	164	460591	165	460592
166	460634	167	460642	168	460668
169	460677	170	460711	171	460713
172	460743	173	460765	174	460766

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175	460770	176	460793	177	460817
178	466887	179	466888	180	466890
181	466894	182	467045	183	467904
184	468044	185	468323	186	468324
187	468641	188	468736	189	468994
190	469056	191	469059	192	469078
193	469103	194	469106	195	469107
196	469108	197	469109	198	469355
199	469496	200	469517	201	469612
202	469623	203	469624	204	469626
205	470051	206	470052	207	470053
208	470054	209	470236	210	470447
211	470448	212	470476	213	470570
214	470571	215	471024	216	471191
217	471238	218	471239	219	471240
220	472066	221	472399	222	472462
223	472980	224	473213	225	473224
226	473484	227	473927	228	473996
229	473997	230	473998	231	473999
232	474119	233	474139	234	474145
235	474146	236	474147	237	474496

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238	474674	239	474963	240	474964
241	475341	242	475342	243	477547
244	477564	245	477570	246	477660
247	477711	248	477712	249	477805
250	477955	251	478044	252	478107
253	478544	254	478633	255	478767
256	478794	257	478858	258	478864
259	478908	260	479042	261	479215
262	479216	263	479217	264	479374
265	479375	266	479414	267	479523
268	479524	269	479667	270	480059
271	480060	272	480383	273	480392
274	480740	275	481074	276	482573
277	482574	278	482857	279	483054
280	483169	281	483174	282	483269
283	483980	284	484275	285	484276
286	484858	287	484865	288	485282
289	485283	290	485507	291	485775
292	486258	293	486259	294	486265
295	486266	296	486297	297	487155
298	487397	299	487408	300	487410



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301	487411	302	487428	303	487506
304	487516	305	487526	306	487536
307	487546	308	487556	309	487565
310	487649	311	487851	312	487895
313	487980	314	487981	315	487982
316	487984	317	488032	318	488058
319	488378	320	488383	321	488436
322	488438	323	488439	324	488619
325	488620	326	498002	327	511491
328	485773	329	113329		

5. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. The attached Appendix provides clear evidence that such conflicting claims exist between the 329 related co-pending applications identified above. However, an analysis of all claims in the 329 related co-pending applications would be an extreme burden on the Office requiring millions of claim comparisons.

In order to resolve the conflict between applications, applicant is required to either:

- (1) file terminal disclaimers in each of the related 329 applications terminally disclaiming each of the other 329 applications, or;

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(2) provide an affidavit attesting to the fact that all claims in the 329 applications have been reviewed by applicant and that no conflicting claims exists between the applications. Applicant should provide all relevant factual information including the specific steps taken to insure that no conflicting claims exist between the applications, or;

(3) resolve all conflicts between claims in the above identified 329 applications by identifying how all the claims in the instant application are distinct and separate inventions from all the claims in the above identified 329 applications (note: the five examples in the attached Appendix are merely illustrative of the overall problem. Only correcting the five identified conflicts would not satisfy the requirement).

Failure to comply with the above requirement will result in abandonment of the application.

#### ***INFORMATION DISCLOSURE STATEMENTS***

6. Receipt is acknowledged of applicant's Information Disclosure Statements filed 4/7/97. In view of the unusually large number of references cited in the instant application (approximately 2,200 originally and 645 in the subsequent IDS) and the failure of applicant to point out why such a large number of references is warranted, these references have been considered in accordance with 37 C.F.R. 1.97 and 1.98 to the best ability by the examiner with the time and resources available.

The foreign language references cited therein where there is no statement of relevance or no translation are not in compliance with 37 C.F.R. 1.98 and have not been considered.

Numerous references listed in the IDS are subsequent to applicant's latest effective filing date of

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9/11/87, therefore, the relevancy of these references is unclear. Also cited are numerous references that are apparently unrelated to the subject matter of the instant invention such as: US Patent # 33,189 directed toward a beehive, GB 1565319 directed toward a chemical compound, a cover sheet with only the word "ZING", a computer printout from a library search with the words "LST" on it and a page of business cards including that of co-inventor James Cuddihy, among others. The relevancy of these references cannot be ascertained. Furthermore, there are several database search results listed in foreign languages (such as German) which list only the title and document information; no copy has been provided, therefore, these references have not been considered.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

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8. Claims 2-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Campbell et al. (#4,536,791).

With respect to claim 2, Campbell taught (Figure 6; col. 8, ln. 46 - col. 11, ln. 55; col. 21, ln. 64 to col. 23, ln. 57) a method for generating a television display at least one receiver station wherein each receiver station included a television monitor for display of television programming (col. 2, ln.53 to col. 3, ln. 26; col. 4, ln. 24-48; figure 1, numeral 36 for example), and a processor for generating and communicating at least some of a video image of the television program to the monitor (Figures 6 and 7; col. 9, ln. 27-42; col. 22, ln. 6-14), converter control logic 104 and text/graphics generator 118. Campbell taught the method comprised the receiving of the television signal which contained digital data (col. 6, ln. 6-35; col. 9, ln. 3-26; col. 10, ln. 50-55), detection of the digital data, and passage of the digital data to the processor (col. 10, ln. 3-10). Further, a video image was taught as being generated and communicated in response to the detected and passed digital data (col. 22, ln. 25-29). Campbell taught a clear-and continue signal (control word causing screen to change to a different display) was provided to the processor responsive to digital data in the television signal which clear and continue signal was a basis to control the processor to provide steps of clearing at least some of an output memory (col. 22, ln.6-55), as by the filling of the memory 130 with appropriate data (col.22, ln. 10-14, ln. 32-34), jumping to a predetermined instruction, as by locating the appropriate category and page on a given line and then collecting the data from that line for the display memory (col. 22, ln. 48-55, ln. 29-34), and commencing or recommencing generation of video image information based on the predetermined instruction, as by display on the user television set after the loading of data into memory by the modulator for display (col. 22, ln. 10-14, ln. 29-34). With respect to claim 3, Campbell taught the detected and passed digital data included a computer program ( a page, via col.22, ln. 25-34, ln. 45-55, provides sequences for display and thus corresponds to a computer program) and the method further comprised storage of the computer program in a memory associated with the processor (the convertor control logic included a buffer for decoding unit 414 via col. 10, ln. 3-7

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and thus for storage of the transmitted data) and determination of an address in said memory to jump to (col. 22, ln.51-55 as by stepping to locate the appropriate category and page on a given line and collecting data for the display memory). With respect to claim 4, Campbell taught a processor interrupt signal caused the processor to respond to the clear and continue signal at a specific time (the control data included subscriber addressing data which included an emergency alert word via col. 14, ln. 36-50 provided only if an emergency has occurred). And the method further comprised detection of a processor interrupt signal in the television signal (for display of such emergency alert message, switching of a channel and turn on of a display via col. 14 as noted above) by communication of the processor interrupt signal to the processor. With respect to claim 5, Campbell taught the clear and continue signal was input to the processor (generator 118) by a controller (control logic 104) and the method further comprised input of data detected in the television signal to the controller and communication of signals from the controller to the processor based on the inputted data (via the data extraction units discussed via col. 9, ln. 3-33).

With respect to claim 6, Campbell taught (Figure 6; col. 8, ln. 46 - col. 11, ln. 55; col. 21, ln. 64 to col. 23, ln. 57) a method for generating a television display at least one receiver station wherein each receiver station included a television monitor for display of television programming (col. 2, ln.53 to col. 3, ln. 26; col. 4, ln. 24-48; figure 1, numeral 36 for example), and a processor for generating and communicating at least some of a video image of the television program to the monitor (Figures 6 and 7; col. 9, ln. 27-42; col. 22, ln. 6-14), converter control logic 104 and text/graphics generator 118. Campbell taught a clear-and continue signal (control word causing screen to change to a different display) was provided to the processor responsive to digital data in the television signal which clear and continue signal was a basis to control the processor to provide steps of clearing at least some of an output memory (col. 22, ln. 6-55), as by the filling of the memory 130 with appropriate data (col.22, ln. 10-14, ln. 32-34), jumping to a predetermined instruction, as by locating the appropriate category and page on a given line and then collecting the data from that line for the display memory (col. 22, ln. 48-55, ln. 29-34), and commencing or

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recommencing generation of video image information based on the predetermined instruction, as by display on the user television set after the loading of data into memory by the modulator for display (col. 22, ln. 10-14, ln. 29-34). Campbell taught a control signal which operated at a transmitter station (programming control system via col. 4, ln. 64-66; col. 7, ln. 16 to col. 8, ln. 7 with reference to the timing signal generator providing enabling signals at appropriate times) communicated the clear and continue signal to a transmitter (via the head-end processors col. 4, ln. 65 to col. 5, ln. 50); and transmission of the clear and continue signal to at least one receiver station to control the processor responsive to provide the steps as provided above (col. 6, ln. 29-43 with reference to the transmission of text data, subscriber address data, and channel control data).

With respect to claim 7, Campbell taught (Figure 6; col. 8, ln. 46 - col. 11, ln. 55; col. 21, ln. 64 to col. 23, ln. 57) a method for generating a television display at least one receiver station wherein each receiver station included a television monitor for display of television programming (col. 2, ln. 53 to col. 3, ln. 26; col. 4, ln. 24-48; figure 1, numeral 36 for example), and a processor for generating and communicating at least some of a video image of the television program to the monitor (Figures 6 and 7; col. 9, ln. 27-42; col. 22, ln. 6-14), converter control logic 104 and text/graphics generator 118. Campbell taught the method comprised the receiving of the television signal which contained digital data (col. 6, ln. 6-35; col. 9, ln. 3-26; col. 10, ln. 50-55), detection of the digital data, and passage of the digital data to the processor (col. 10, ln. 3-10). Campbell taught a clear-and continue signal (control word causing screen to change to a different display) was provided to the processor responsive to digital data in the television signal which clear and continue signal was a basis to control the processor to provide steps of clearing at least some of an output memory (col. 22, ln. 6-55), as by the filling of the memory 130 with appropriate data (col. 22, ln. 10-14, ln. 32-34), jumping to a predetermined instruction, as by locating the appropriate category and page on a given line and then collecting the data from that line for the display memory (col. 22, ln. 48-55, ln. 29-34), and commencing generation of video image

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information based on the predetermined instruction, as by display on the user television set after the loading of data into memory by the modulator for display (col. 22, ln. 10-14, ln. 29-34). Campbell taught a processor interrupt signal caused the processor to respond to the clear and continue signal at a specific time (the control data included subscriber addressing data which included an emergency alert word via col. 14, ln. 36-50 provided only if an emergency has occurred).

***CLAIM REJECTIONS - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

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*Response to Arguments*

10. In response to the amendment, the applicant's remarks are not convincing, with respect to the remark that Campbell does not teach a method for "generating a television display at a receiver station", this is clearly taught by the generation of text messages using the convertor control logic and text message generator and can be clearly seen via figure 17 (312) wherein a mere switching of the screen to black is considered generation of a television display, in addition to the generation of textual data on the display which is generated responsive to at least a control word received in the television signal. The 'clear and continue' via the claim language is merely suggestive of an instruction which at least clears a portion of a memory (this can be considered simply generating a black screen), jumping to a predetermined instruction (considered stepping down through the data to locate a page on a given line and then collecting data for the display memory via col.22,ln.45-55) and generating video image information based on the instruction (the data is provided to the memory 130 for use on the television display), thus although Campbell does not specifically provide the phrase 'clear and continue', it is clear that the functions claimed, and suggested throughout the instant specification as being well known in the art, are provided by the Campbell reference in sufficient manner such that each of the limitations claimed are performed by the Campbell reference. With respect to claim 6, the suggestion that a control signal does not operate at a transmitter station of Campbell to "communicate the clear and continue signal to a transmitter" is not agreed with, Campbell clearly teaches the processing of the subscriber addressing and channel control data being inserted in the vertical interval of the video signal, which is then connected to the standard head-end processor (col.7,ln.40-col.8,ln.7) and thus a transmitter which operates at the appropriate time and under control of a synch extractor and timing generator to communicate the signal to the transmitter under control of at least one control signal. With respect to claim 7, the remarks are the same as directed to claim 2 and as addressed above, in addition, though the present invention does not recite a requirement for insertion of data on the vertical interval, the claimed invention likewise does not exclude such 'requirement' by use of open ended language.



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11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for response to this final action is set to expire THREE MONTHS from the date of this action. In the event a first response is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than SIX MONTHS from the date of this final action.

12. **Any response to this final action should be mailed to:**

**Box AF**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

(703) 308-9051, (for formal communications; please mark "EXPEDITED  
PROCEDURE")

**Or:**

(703) 308-5403 (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,  
Arlington, VA., Sixth Floor (Receptionist).

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13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott L. Weaver whose telephone number is (703) 308-6974. The examiner can normally be reached on Monday through Friday from 8:00 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Krista M. Zele, can be reached on (703) 305-4701. The fax phone number for this Group is (703) 308-5403.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [[krista.zele@uspto.gov](mailto:krista.zele@uspto.gov)].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.



KRISTA ZELE  
SUPERVISORY PATENT EXAMINER  
GROUP 2700